

REMARKS

Claims 1-73 are pending in the present application. Applicant respectfully requests confirmation that claims 48-73 have been withdrawn from consideration rather than claims 47-73 as mentioned in the Office Action because rejoining Groups I and II should result in only claims 48-73 being withdrawn from consideration.

Applicant gratefully thanks Examiner Torres Velazquez for rejoining claims 1-3, 5-6 and 8-25. Applicant is also grateful to Examiner Torres Velazquez for the telephone interview with Applicant's representative, Mr. Rattan Nath on December 14, 2004. The single issue that remained unresolved was whether the description of claim 1 adequately described a product that was distinct from that disclosed by US Patent No. 5,447,462 issued to Smith et al. ("Smith").

The issue of whether products manufactured using the claimed methods are the same has been at the forefront of the examination of this application from the very beginning. IN part, this is a reflection of the close connection between the method of making the products and the products themselves since efficient handling of adhesive films is important in efficiently making the distinctive products. Indeed, the cited art, including the Smith reference, reveals many different choices in the form of the adhesive in order to achieve a desirable product.

The Dec 14 interview also covered (i) recognition of the perfection of the priority claim in this application, about which Examiner Torres Velazquez agreed to follow-up; (ii) corrections to the drawings; (iii) the distinction between films and webs; and (iv) amendment of claim 2 to place it in order for allowance, which amendment was deemed acceptable by the Examiner. Examiner Torres Velazquez also requested a detailed description of the technology and the methods for producing fabric laminate, and brassieres in particular. The discussion encompassed molding of cups, handling of materials as well as prelamination procedures.

The December 14 also clarified that the issue of whether products by the claimed method, which is also described in the examined claims, and, hence, have been searched and examined, are distinct from those described by Smith, is the primary unresolved issue. Applicant's representative pointed out that Smith itself provides the distinction because its abstract states that its articles exhibit differential stretch characteristics with a primary elongation being in a predetermined direction due to the use of web adhesives. Nevertheless, during the December 14 interview Examiner Torres Velazquez suggested that it was not clear whether the products were distinct from those disclosed by Smith. Applicant requested the

Examiner to suggest amendments that would overcome this rejection, to which request Examiner Torres Velazquez was agreeable.

In accordance with the remaining issue of distinguishing products made by the inventive methods from those made by Smith identified in the December 14 interview, Applicant has amended claim 1 to overcome this ground for rejecting the pending claims. As discussed in this response, the amendments to the claims place the pending claims in order for allowance in accordance with the December 14 interview.

A subsequent call on December 30, 2004 by Mr. Rattan Nath to Examiner Torres Velazquez to reach agreement on the amendment to claim 1 presented herein was unsuccessful. Examiner Torres Velazquez expressed a preference for reviewing the proposed amendment in a formal response. Because, adhesives containing polyurethanes have already been a subject of searches relied upon in sections 8 and 13 of the Office Action, in evaluating claims 14-21, this amendment does not raise any new issues that require a new search.

Response to the Office Actions' Evaluation of Prior Arguments

The final product made by the disclosed method and system is different from that disclosed by Smith. The Office Action errs in (i) discounting (in section 1b.) Applicant's argument based on the alleged absence of 'film' in claim 1, and (ii) characterizing (in section 1a.) the final product obtained using the disclosed procedure as being similar to that disclosed by Smith. Claim 1 does recite the limitation of a film and the amended claim 1 describes a product that is not similar to that disclosed by Smith.

First, claim 1 includes the limitation of a film. Claim 1 recites "the adhesive layer pre-laminated on the first fabric in the form of a film tacked on the first fabric." This limitation clearly excludes products made with adhesives layers that are not in the form of a film. Second, Smith teaches the use of webs rather than films. Smith itself discloses and emphasizes that fabrics made with webs are different from those made with other types of adhesives in its abstract and description. Office Action's interpretation of films and webs being the same is in conflict with both the known distinction between a web and a film and with Smith's teaching away from forms of adhesives other than webs.

The unusual expression 'open net-like film' in the abstract of Smith stands for a type of web rather a film. The expression 'open net-like film' is unusual and does not have a well settled meaning. A search of the Web carried out on December 10, 2004 using the GOOGLE search engine came up with only one document-- the Smith reference itself. This result was discussed in the December 14 interview. A copy of the search result is attached.

'Open net-like film' should be interpreted by reference to its component terms. The term "open net-like film" of Smith is in agreement with the well understood meaning of a web as having substantial and regularly placed openings. A web is a latticed structure by definition, see, e.g., the American Heritage College Dictionary, third edition, published by Houghton Mifflin Company, and therefore a substantial part of it is in the form of pores. The term 'net' refers to "an openwork fabric made of threads or cords that are woven or knotted together at regular intervals" according to The American Heritage® College Dictionary of the English Language, Third Edition, published by the Houghton Mifflin Company. The term 'open' emphasizes the substantial openings, while the term 'film' presumably stands for a layer of 'open net-like' material. As in the case of a web, regularly spaced large pores are not a part of a film. This distinction was pointed out by the Applicant to clarify the distinction made in the specification as well.

The specification of the present application also distinguishes the web of Smith from the adhesive film; for instance paragraph 64 of the published application specifically notes that an "adhesive made in the form of a film provides more consistent physical properties than webs, powders, or liquid adhesives." The distinction made between films and webs in the specification of the present application also distinguishes webs in the form of an open net-like film.

Therefore, Applicant respectfully requests that the unusual undefined expression 'open net-like film' not be interpreted in a manner that is not supported by Smith itself to interpret the products due to Smith as being similar or the same as the products covered by the pending claims. The abstract of Smith itself emphasizes that its products display a differential stretch characteristics due to the use of webs, thus distinguishing them from those covered by claim 1. Moreover, Smith does not even suggest the presence of a polyurethane in its adhesive and instead emphasizes the preferred use of polyamides.

It is respectfully requested that the difference between the products resulting from Applicant's claimed techniques and those disclosed in the prior art be recognized. Such a recognition is compelled by the difference between a web and a film.

In addition, in view of the December 14 interview with Examiner Torres Velazquez, Applicant has amended claim 1 to include the limitation that the adhesive film comprises polyurethane. This limitation is also completely absent from the prior art of record and provides an additional ground for distinguishing Smith from the claimed invention. Many other differences between the products were discussed in the Dec 14 interview.

Rejoining of Withdrawn Claims

The methods of prior art have been considered in making the rejection based on alleged similarity between the product due to prior art methods and the claimed invention. The detailed discussions in the interview and prior responses also establish that notwithstanding the restriction requirement, examination of the elected claims 1-47 has naturally resulted in the examination of the subject matter of withdrawn claims 48-73. This more extensive examination is apparent in the case of withdrawn claim 48, which was restricted out for being directed to a brassier. Brassieres and their manufacture was specifically discussed in the December 14 interview, and has been addressed by all Office Actions and responses thereto. Indeed, the major objection made by the Office Action is that *the method of making a product is insufficient to distinguish it from the prior art*.

Similarly, currently withdrawn claim 63 describes methods that are clearly not in the prior art and have been considered in the context of examined claims 2 and 27. Similarly withdrawn claim 49 and the prelamination step are also not taught by the prior art. Further, methods for manufacturing laminated garments and brassieres have been discussed extensively in the interview and are both the subject of the cited art and the claimed invention. Hence, Applicant respectfully requests that the currently withdrawn claims 48-73 also be allowed because the thorough examination has also established their patentability.

In another aspect, although Smith does not disclose or suggest the use of underwires as an alternative to its control panels for providing support, the Office Action relies (in section 1c. of the Office Action) upon the absence of a teaching in Smith *precluding* the use of insert wires to combine it with US Patent No. 5,967,876 to Kollmanther et al. (“Kollmanther”). Such reliance is impermissible in that it does away with even need to identify a motivation to combine the references. The Office Action alleges that despite Smith’s preference for control panels, one of ordinary skill in the art would be motivated to combine Smith with Kollmanther to provide support by way of underwires. This assumption is based only on impermissible hindsight and assumes that Smith’s disclosure is somehow deficient. Therefore, it is respectfully reiterated that Smith is not suitable as a reference and rejections based on combining Smith with Kollmanther be withdrawn.

Objection and Corrections to the Drawings

In section 4 the Office Action objects to the drawings for failing to show the “third layer of woven, stretch fabric.” However, Figures 11 and 12, and their corresponding description in the specification identify them as illustrative of the “third layer of woven,

stretch fabric” in the context of molding a cup. Accordingly, Applicant respectfully requests that the objection be withdrawn.

Applicant is enclosing Replacement Drawings for Figures 1-3 and 6. These drawings correct inadvertent errors. Applicant noticed that the submitted formal drawings 1-3 differed from the original drawings due to errors in the captions of Figures 1-3. Accordingly, they have been corrected to identify the correct type of urethane for each curve.

Applicant also noted that the reference numerals in Figure 6 disagreed with those in the written description. This has been corrected by changing numeral -615- to -610- and numeral -610- to -625-. The correction of these errors does not introduce any new matter.

Rejection Under § 112 (second paragraph)

In sections 5-6 the Office Action has rejected claims 2-3 under 35 U.S.C. § 112, second paragraph, as being incomplete pursuant to MPEP § 2172.01. MPEP § 2172.01 points out that a rejection under 35 U.S.C. § 112, second paragraph, is proper if subject matter disclosed to be essential in the specification or other statements in the record is missing from a claim or that essential elements of the claim are not interrelated by the rejected claim.

Amended claim 2 and support therefor satisfies 35 U.S.C. § 112, second paragraph, because the disclosure, as filed, “reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.” *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995). Applicant has amended claim 2 to recite that the “woven moldable stretch fabric” is sandwiched within” the fabric laminate. Support for this amendment is found, for instance, in paragraphs 52 and 61 of the published specification of the present application as was pointed out in the December 14 interview. Accordingly, it is respectfully requested that the rejection of both claims 2-3 be withdrawn since the rejection of claim 2, on which claim 3 is dependent, has been overcome.

Rejections Under § 102

In section 7-8 the Office Action has rejected claims 1, 4-9, and 12-24 as being anticipated under 35 U.S.C. § 102(e) by the US Patent No. 6,645,040 issued to Rabinowicz et al. (“Rabinowicz”). Rabinowicz has an effective filing date that is later than that of the present application. Therefore, it is not available as a reference. The present application claims priority to Provisional Patent Application No. 60/330,119 filed on October 16, 2001, which date is before the November 9, 2001 filing date of Rabinowicz. This provisional application discloses the subject matter of the rejected claims 4-9, and 12-24. The claim to priority was properly made in the executed declaration filed with the present application on

November 30, 2001 and subsequently perfected by way of the required amendment to the first paragraph of the present application in a preliminary amendment filed on March 14, 2003. Applicant respectfully requests that this claim to priority be recognized since attention to the underlying executed declaration was repeatedly drawn in filings made on October 16, 2002 and on March 14, 2003. Accordingly the rejection of claims 1, 4-9, and 12-24 should be withdrawn since Rabinowicz is not prior art to the claimed invention.

In section 9 the Office Action has rejected claims 1-7, and 27 as being anticipated under 35 U.S.C. § 102(e) by Smith. Smith discloses in its abstract that its adhesive web includes an “open net-like film.” As discussed earlier in this response, the unusual term ‘open net-like web’ refers to a type of web and indicates that the products according to the disclosure of Smith are distinct from those in accordance with the claimed invention. It is respectfully requested that in view of Smith’s failure to disclose the use of films as in the claimed invention, the rejection of claims 1-7, and 27 under 35 U.S.C. § 102(e) by Smith be withdrawn.

Rejection Under § 103(a)

The Office Action has rejected claims 25-26 over Smith in view of the Kollmanther.

The Office Action has also rejected claims 28-31 and 46-47 over Smith and further in view of the US Patent No. 5,984,762 to Tedeschi et al. (“Tedeschi”).

The Office Action has also rejected claims 8-24 and 28-47 over Smith and further in view of Rabinowicz.

As demonstrated earlier, Rabinowicz is not prior art to the claimed invention in view of the perfected priority claim to the underlying provisional application. Since the deficiencies of Smith are not cured by either Kollmanther or Tedeschi, the rejection of claims 8-24, 25, 26, 28-47 under § 103(a) should be withdrawn.

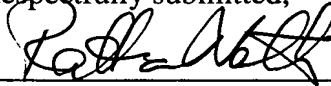
CONCLUSION

All of the various arguments and grounds for the rejection of pending claims 1-47 have been overcome. No new matter is introduced by way of any of the amendments. Therefore all of the pending claims, including those dependent on independent claim 1 are now allowable.

No fee is believed to be due for this submission other than the fee for a Request for Continued Examination. In the event that any additional fee is required, please charge the required fee to JONES DAY Deposit Account No. 50-3013.

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Respectfully submitted,



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